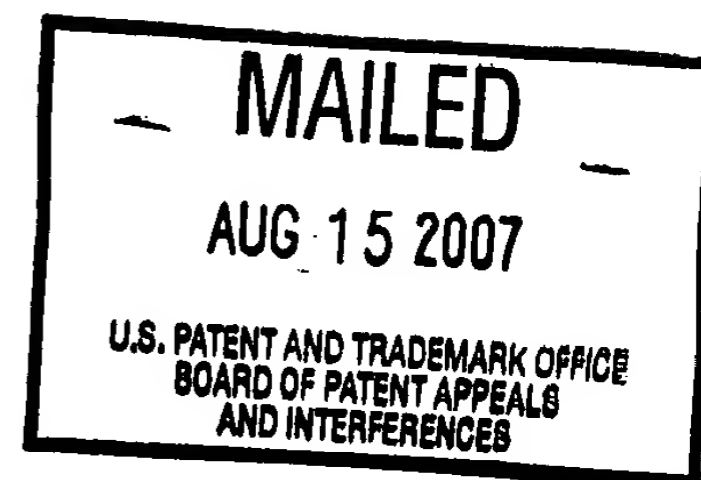


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: WALTER C. FIERS

Appeal No. 2007-3750
Application No. 08/452,658



ORDER REMANDING APPEAL TO EXAMINER

The Board of Patent Appeals and Interferences (Board) electronically received this application on July 28, 2007. The application is not ready for review and consideration by the Board for the reasons noted below. Accordingly, the application is herewith being returned to the Examiner to take action consistent with the guidance provided by this remand.

BACKGROUND

On September 26, 2006, an Examiner's Answer was mailed and it included a new grounds of rejection, Claims 31 and 34 were rejected under 35 U.S.C. §102(g) (under *res judicata*) as being clearly anticipated by either one of Sugano et al (5,514,567) or Sugano (5,326,859).

REPLY BRIEF AND REQUEST TO REOPEN PROSECUTION

On November 23, 2005, Appellant filed a Reply Brief under 37 CFR § 1.111 and Request to Reopen Prosecution in response to the Examiner's Answer mailed September 26, 2006.

A review of the record revealed that this request had not been considered.

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ORDER RETURNING UNDOCKETED APPEAL

On May 4, 2006, an Order Returning Undocketed Appeal was mailed. The Order directed the Examiner to hold the Appeal Brief defective and require appellant to file a Supplemental Appeal Brief; and to consider the Request to Reopen Prosecution under 37 CFR § 1.111.

AMENDED APPEAL BRIEF

On December 4, 2006, Appellant filed an Amended Appeal Brief correcting the deficiencies in response to the Notice of Appeal Brief Non-Compliance mailed June 2, 2006.

SECOND EXAMINER'S ANSWER

On March 27, 2007, a Second Examiner's Answer was mailed. In the Second Examiner's Answer, the Examiner withdrew the new grounds of rejection. The Examiner then forwarded the application to the Board of Patent Appeals and Interference for consideration of the appeal.

REPLY UNDER 37 CFR § 1.111
AND REQUEST TO REOPEN PROSECUTION

The Reply under 37 CFR § 1.111 and Request To Reopen Prosecution is treated by the Board as a request to withdraw the appeal. 37 C.F.R. § 41.39(b)(1). In addition, 37 CFR § 41.39(b)(1) states that "[a] request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. "

According to 37 CFR § 1.112:

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After reply by applicant or patent owner (§ 1.111 or § 1.945) to a non-final action and any comments by an inter partes reexamination requester (§ 1.947), the application or the patent under reexamination will be reconsidered and again examined. The applicant, or in the case of a reexamination proceeding the patent owner and any third party requester, will be notified if claims are rejected, objections or requirements made, or decisions favorable to patentability are made, in the same manner as after the first examination (§ 1.104). Applicant or patent owner may reply to such Office action in the same manner provided in § 1.111 or § 1.945, with or without amendment, unless such Office action indicates that it is made final (§ 1.113) or an appeal (§ 41.31 of this title) has been taken (§ 1.116), or in an inter partes reexamination, that it is an action closing prosecution (§ 1.949) or a right of appeal notice (§ 1.953).

The Second Examiner's Answer, mailed on March 27, 2007, does not comply with 37 CFR § 1.112.

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CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner for appropriate action on the following:

- 1) to vacate the Second Examiner's Answer, dated March 27, 2007;
- 2) to reconsider and again examine the application consistent with 37 CFR §1.112 and Office policy; and
- 3) to notify Appellants of the Examiner's reconsideration consistent with 37 CFR § 1.112 and Office policy.

BOARD OF PATENT APPEALS
AND INTERFERENCES



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